REMARKS

The Examiner, Mr. Ortez-Criado, is thanked for the courtesy extended applicants' attorney during the telephone discussion of August 31, 2004, in which the Examiner clarified his position concerning "direction of alignment" as recited in the claims, and it was pointed out that with respect to the semiconductor laser chips, the direction of alignment, in accordance with the present invention, represented by the direction of mounting of the chips with respect to one another, with the Examiner indicating that amendment to recite such features would raise new issues requiring further search and/or consideration. In light thereof, applicants submit herewith an RCE while amending the specification and claims to more clearly define the present invention.

Turning to the amendment of the specification and claims, applicants note that the paragraph beginning at page 15, line 1 of the specification, has been amended to clarify that as illustrated in Fig. 1 of the drawings, the semiconductor laser chips 4a and 4b are mounted in a side-by-side mounting arrangement so that an alignment or mounting direction thereof extends substantially perpendicular to the tracking servo direction 14. Similarly, as shown in Fig. 1, the laser beam 6a emitted by the semiconductor laser chip 4a impinges on the optical disk 15 to form one optical spot as shown, while the laser beam 6b emitted by the semiconductor laser chip 4b impinges on the optical disk 15 to form an other optical spot spaced from the one optical spot along the track 17 of the laser beam 6a, and a line extending between the optical spot of the one laser beam 6a and the other optical spot of the laser beam 6b extends or has an alignment direction which is substantially perpendicular to the tracking servo direction 14. By the present amendment, independent claims 1, 6 and 16 have been amended to recite the aforementioned features, which are clearly disclosed and illustrated in this application, and applicants submit that such features

are not disclosed or taught in the cited art, as will become clear from the following discussion.

The rejection of claims 1, 6 and 16 under 35 U.S.C. 102(e) as being anticipated by Kajiyama et al, U.S. Patent No. 6,522,990 and the rejection of claims 2-5 and 7-10 under 35 U.S.C. 103(a) as being unpatentable over Kajiyama et al, U.S. Patent No. 6,522,990 in view of Uchizaki et al, U.S. Patent No. 6,646,975 are traversed insofar as the rejections are applicable to the present claims, and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 U.S.C. 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 U.S.C. 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of

the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the recent decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". The court pointed out:

> The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Looking to Sketch IA provided by the Examiner in the Office Action of June 1, 2004 representing Fig. 2 of Kajiyama et al and annotated in the manner indicated, it is readily apparent that chips 1a and 1b are mounted side-by-side on a mounting surface in a manner corresponding to the mounting of chips 4a and 4b of the present invention as illustrated in Fig. 1 of the drawings of this application. While the

Examiner contends that the direction of alignment of the laser chips corresponds to the emitting direction of lasers from such chips, by the present amendment, there can be no question that the side-by-side mounting of the laser chips 1a and 1b of Kajiyama et al corresponds to the direction of side-by-side mounting of the laser chips in the present invention and that such mounting direction of the chips of Kajiyama et al as represented by Sketch IA forwarded by the Examiner extends perpendicular to the direction of alignment of laser chips as indicated by the Examiner in such Sketch. Likewise, in Sketch IA, the Examiner has indicated the tracking servo direction and it is apparent that in accordance with the disclosure of Sketch IA provided by the Examiner, in Kajiyama et al, the mounting direction of the laser chips with respect to one another on the mounting surface extends substantially parallel to the tracking servo direction. Applicants submit that this arrangement of Kajiyama et al is contrary to the claimed features of independent claims 1 and 6, as amended, which provides that the mounting direction of the laser chips with respect to one another extends substantially perpendicular to the tracking servo direction as clearly illustrated in Fig. 1 of the drawings of this application, for example. Thus, with respect to the rejection under 35 U.S.C. 102, it is readily apparent that the features of the independent claims 1 and 6 are not disclosed by Kajiyama et al and applicants submit that the independent and dependent claims patentably distinguish thereover.

With regard to the features of claim 16 of this application, as amended, it is assumed that the Examiner contends that the laser beams from the respective chips 1a and 1b of Kajiyama et al impinge and form optical spots which are spaced from one another in a vertical direction of the recording medium, as represented by the surface 99a and 9a of the recording medium 99 of Kajiyama et al, and that such spacing which extends in a vertical direction would apparently be perpendicular to the tracking servo direction. However, applicants note that the vertical spacing in

Kajiyama et al does not represent optical spots spaced from one another along a direction of the track which are formed by respective ones of the laser beams, Therefore, applicants submit that Kajiyama et al does not disclose optical spots spaced from one another along a direction of the track, and Kajiyama et al does not disclose in the sense of 35 U.S.C. 102, the recited feature of claim 16 that a line extending between the optical spots which are spaced from one another along a direction of the track and are formed on the optical information medium by respective ones of the laser beams irradiated from the laser chips mounted on the identical surface extends substantially perpendicular to the tracking servo direction. That is, apparently in Kajiyama et al, the optical spots are formed at the same position along the track direction, albeit possibly being formed at different surfaces in a vertical direction. Accordingly, applicants submit that Kajiyama et al also fails to disclose in the sense of 35 U.S.C. 102 the recited features of claim 16, and claim 16 should be considered allowable thereover.

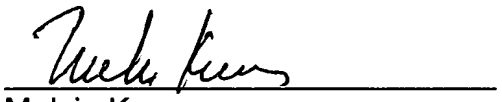
With regard to the combination of Uchizaki et al with Kajiyama et al in relation to dependent claims 2-5 and 7-10, the Examiner recognizes that the recited features are not disclosed by Kajiyama et al, and applicants submit that as pointed out above, Kajiyama et al fails to disclose the features of parent claims 1 and 6. Applicants submit that Uchizaki et al also fails to overcome the deficiencies of Kajiyama et al in that as pointed out in Sketch III by applicants submitted with the Amendment of March 18, 2004, the tracking servo direction in Uchizaki et al is represented by the Y direction and the laser chips 31 are mounted in a side-by-side arrangement in a manner similar to that disclosed by the present invention and that of Kajiyama et al, whereby the mounting direction of the laser chips and the tracking servo direction extend in parallel to one another rather than perpendicular to one another, as recited in independent claims 1 and 6 and therewith the dependent claims. Accordingly, applicants submit that the independent and dependent claims of this application also

patentably distinguish over this proposed combination of references in the sense of 35 U.S.C. 103. With regard to the features of the dependent claims 2-5 and 7-10, applicants submit that contrary to the position set forth by the Examiner, the combination fails to provide a first reflection plane formed on the same plate as the mounting surface for the laser chips as recited in dependent claims 2 and 7 and the independent claims thereof. Thus, applicants submit that the dependent claims recite further features which when considered in conjunction with the parent claims, further patentably distinguish over this proposed combination of references in the sense of 35 U.S.C. 103 and should be considered allowable thereover.

In view of the above amendments and remarks, applicants submit that all claims present in this application should now be in condition for allowance, and issuance of an action of a favorable nature is courteously solicited.

To the extent necessary, applicant's petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 01-2135 (500.40513X00) and please credit any excess fees to such deposit account.

Respectfully submitted,



Melvin Kraus
Registration No. 22,466
ANTONELLI, TERRY, STOUT & KRAUS, LLP

MK/cee
(703) 312-6600